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PATENT APPLICATION



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BOARD OF PATENT APPEALS AND INTERFERENCES

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| In re Application of: |) | |
| | : | Examiner: Philip C. Lee |
| SEBASTIEN JEAN, et al. |) | |
| | : | Group Art Unit: 2152 |
| Application No.: 09/853,767 |) | |
| | : | Technology Center: 2100 |
| Filed: May 14, 2001 |) | |
| | : | |
| For: NETWORK DEVICE MIMIC |) | |
| SUPPORT | : | August 9, 2007 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is submitted in support of Appellants' appeal from the final rejection of Claims 1 to 40 in the above-identified application, and in response to the Examiner's Answer dated June 11, 2007.

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(1) STATUS OF CLAIMS

The Examiner's Answer did not object to the Status set out in Appellants' Brief On Appeal. For convenience, that Status is repeated here.

Claims 1 to 40 are pending, of which Claims 1 and 33 are independent. All claims have been rejected finally under 35 U.S.C. § 103(a), and all such rejections are being appealed.

Independent Claim 1 has been finally rejected under 35 U.S.C. § 103(a) over U.S. Application Publication No. 2002/0080391 (Sugiura) in view of U.S. Patent No. 6,816,270 (Cooper).

Independent Claim 33 has been finally rejected under 35 U.S.C. § 103(a) over Sugiura and Cooper in view of U.S. Patent No. 6,611,863 (Banginwar).

The remaining claims are all dependent, and have been finally rejected under 35 U.S.C. § 103(a) as above, or further in view of one or more of the following: U.S. Patent No. 6,240,456 (Teng), U.S. Patent No. 6,757,280 (Wilson), U.S. Patent No. 6,157,950 (Krishnan), U.S. Patent No. 6,020,973 (Levine), and U.S. Patent No. 6,742,039 (Remer).

(2) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner's Answer did not object to the Grounds of Rejection as set out in Appellants' Brief On Appeal. For convenience, those Grounds are repeated here.

1. Whether the rejection of Claim 1 under 35 U.S.C. § 103(a) over Sugiura in view of Cooper should be reversed.

2. Whether the rejection of Claim 33 under 35 U.S.C. § 103(a) over Sugiura and Cooper in view of Banginwar should be reversed.

(3) ARGUMENT

Insofar as Appellants are able to determine, paragraphs 1 through 78 of the Examiner's Answer (found on pages 4 through 24) are exactly identical to paragraphs 4 through 81 of the Final Rejection. Accordingly, this section will address new material that commences on page 24 of the Examiner's Answer.

I. Independent Claim 1

- A. There is no *prima facie* case since important features of the claim are not found in the applied art.

Appellants' position, reiterated from their main Appeal Brief, is that a *prima facie* case of obviousness has not been established, for the reason that the prior art does not disclose or suggest at least four features claimed therein.

As a first feature, the applied art does not disclose or suggest that an incoming message from a client network device to a computing device is "addressed to a network address of a target network device". The Examiner's Answer maintains that Sugiura discloses this feature, and provides the following explanation:

"Sugiura teaches a terminal device generates a message (HTTP data DT) by adding a header with an address of **the target printer (i.e. target device)** to be used for printing to the print data (page 5, paragraphs 95). A **printer server (target device)** acquires the message with information about the address of the printer as an output target from the terminal device and transmits the print data to the designated printer (page 5, paragraph 114). This means that the address of the target printer is used by the printer server in order to transmit the print data (i.e. the message) to a designated printer (i.e. network address of the printer) [.]"
Examiner's Answer, page 25 (emphasis added).

The Examiner's Answer not only confuses which device is the target device and which is the computing device, but also substitutes its own broader claim language for Appellants' claim language.

Much of the contention in this case centers on the identity of the devices that participate in the claimed method, and the functionality performed by each. There are three participants in the method of Claim 1: a computing device (which performs the claimed method), a client network device, and a target network device. The central unifying premise of the final rejection is that Sugiura's print server 23 corresponds to the claimed computing device, which when modified by Cooper performs the claimed method, and which (pursuant to the claim language) has first and second network interface cards for connecting the computing device to external and local networks, respectively.

The Examiner's Response, however, attempts to side step the premise of the final rejection, by now (and for the first time) taking the position that the print server is also the target network device. It is clear that this shift in position is an attempt to address Appellants' long-standing argument that messages in Sugiura are addressed to the network address of the print server 23 and not to that of a target network device. With this shift in position, where Sugiura's print server 23 is now viewed as the target network device, it is clear that the Examiner concedes that messages in Sugiura are addressed to the network address of the print server, and not to the network address of the target devices. However, this shift in position undermines completely the central premise of the final rejection, since there is nothing left in Sugiura to correspond to the claimed computing device which performs the method of Claim 1.

Furthermore, as stated above, the Examiner's Answer substitutes its own broader claim language for that of the actual claim. It might be true, as stated in the Examiner's Answer, that Sugiura's print server 23 "uses" the address of the target printer in order to transmit the print data to the designated printer. However, whether the address of the target printer is or is not "used" by Sugiura's print sever is irrelevant. In the context of Appellants' claim language, what matters is: to whose *network address* is the message *addressed to*. Clearly, Sugiura's message is addressed to Sugiura's print server, and not to a target device. It cannot be justifiably be said that "using" an address is interchangeable with the actual claim language, which specifies that a message is "addressed to a network address of" a target device. More generally, it is not proper for the Examiner to substitute his own broader terms for the actual claim language, in an effort to fit the prior art.

Simply put, the Examiner cannot have it both ways: either Sugiura's print server 23 corresponds to the claimed computing device or to the claimed target device. If it corresponds to the claimed computing device, then as tacitly conceded by the Examiner the HTTP messages of Sugiura are not "addressed to the network address of the target device", but rather are addressed to the network address of the print server. Alternatively, if Sugiura's print server 23 corresponds to the claimed target device, then there is nothing left in the applied art to correspond to the claimed computing device, which performs the method of Claim 1, and which includes first and second network interface cards for respectively connecting the computing device to external and local networks.

In his Answer, the Examiner adds that "one skilled in the art knows that data transmitted in a network must include a header with a destination address in order to

designate a receiver." Examiner's Answer, page 25. Even if this statement is true, it is not seen how this might possibly lead to the Examiner's conclusion that such data is "addressed to a network address of a target network device", or how this might possibly change the fact that Sugiura's message is addressed to Sugiura's print server, and not to a target device as claimed by Appellants.

As a second feature, the applied art does not disclose or suggest a determination of whether an application module residing in the computing device is configured to process a functionality requested by the incoming message. More specifically, the determination concerns whether or not the "computing device" is configured to process the functionality requested by the incoming message.

The Examiner's Answer maintains that Cooper discloses this feature, and provides the following explanation:

"Cooper teaches Intelligent printer driver (IPD) (application module) determines if it **should** process a functionality requested (i.e. printing function) in a message by determining if the **selected printer** supports the requested functionality. The IPD processes the requested function if the selected printer does not support the requested function (col. 6, lines 23-34; col. 7, lines 29-62). This means IPD determines if it is configured to process the requested function based on the result of determining if the requested function is supported/unsupported by the selected printer [.]" Examiner's Answer, page 26 (emphasis added).

The Examiner's Answer thus asserts that Cooper's IPD determines if it "should" process a requested functionality by determining whether a selected printer supports the requested functionality. From this, the Examiner's Answer concludes that

there is a determination of whether Cooper's IPD "is configured" to process a requested functionality.

Again, the Examiner's Answer substitutes its own broader language for Appellants' claim language. Whether Cooper's IPD *should* process a requested functionality is irrelevant. What matters is whether there is a determination if Cooper's IPD *is configured to* process a functionality, as claimed. As stated in Appellants' Appeal Brief, there is no such determination. Rather, Cooper's determination is whether the selected printer supports the functionality. Of course, the selected printer corresponds to the "target network device", not the "computing device", such that any determination made by Cooper does not correspond to the claimed determination.

Moreover, the Examiner's Answer apparently asserts that a determination of whether Cooper's IPD "should" process a functionality somehow corresponds to a determination of whether Cooper's IPD "is configured" to process a functionality.

These terms are simply not interchangeable. It can not be said that determining whether a device "should" perform some functionality, as asserted by the Examiner, corresponds to an explicit determination of whether a device "is configured" to perform a functionality, as claimed. The former is, at best, an abstraction without reference to any point in time. The latter is a technical fact; a device either is or is not configured to perform a function, and a determination to this effect is made.

The Examiner cannot properly substitute broader language for Appellants' claim language in order to fit prior art. The claim language recites a determination of

whether an application module *is configured* to process a functionality - not whether it should be, or will be, or any other substitute language.

Moreover, it is not seen how a determination of whether functionality is supported or unsupported by Cooper's printer can possibly produce any determination of the abilities of Cooper's IPD. The claim specifies that the determination is made of the computing device (which according to the Examiner is Cooper's IPD), not the target device (Cooper's printer). The Examiner's Answer cannot properly substitute a determination of the abilities of one device for the determination of the abilities of a different device.

Turning to the third and fourth features, the Examiner's answer provides nearly identical reasoning in its response, and both the third and fourth feature will therefore be addressed concurrently. As the third feature, the applied art does not disclose or suggest redirecting the incoming message to the application module in the case that the application module is configured to process the functionality. As the fourth feature, the applied art does not disclose or suggest passing the incoming message through the local network to the target network device residing on the local network in the case that the application module is not configured to process the functionality.

The Examiner maintains that Cooper discloses both of these features, and provides the following explanation:

"[A] decision must be made to determine if the message should be directed to IPD (application module) for performing the requested functionality (by performing software simulation) if IPD is configured to process the requested function (i.e. IPD is configured to process the requested functionality if it is determined that the requested functionality is unsupported by the selected printer) (col. 6, lines 23-34; col. 7, lines 29-62), or determine if the message should be sent (passing the message) to the

printer (target network device) if the IPD is not configured to process the functionality (i.e., IPD is not configured to process the requested functionality if it is determined that the requested functionality is supported by the selected printer)[.]" Examiner's Answer, pages 26 to 27.

To reiterate, in Appellants' view, Cooper does not disclose any determination of whether its IPD is configured to process the functionality requested by a message; rather, any determination made by Cooper is a determination of whether a printer supports the message (a point which is echoed in the Examiner's own language above). Since Cooper does not disclose the claimed determination, it logically follows that Cooper can not disclose any steps based on such a determination.

The Examiner's Answer also states that "IPD is configured to process the requested functionality if it is determined that the requested functionality is unsupported by the selected printer", and that "IPD is not configured to process the functionality if it is determined that the requested functionality is supported by the selected printer."

As noted above, it is not seen how determining the abilities of Cooper's printer possibly produces any determination of the abilities of Cooper's IPD. The Examiner's Answer cannot properly substitute a determination of the abilities of one device for the determination of the abilities of a different device.

- B. There is no motivation to combine Sugiura and Cooper, or otherwise to modify the actual disclosures of these references to meet the language of the claims.

Without citation to authority, the Examiner's Answer conclusorily states that "in view of KSR ... the requirements for motivation have changed significantly.

Accordingly, the examiner will not address the case law cited by the appellant."

Examiner's Answer, page 28.

Appellants first wish to point out that this is considered a new ground of rejection. In particular, this Appeal was filed during pendency of KSR, and, notwithstanding that the statutory basis remains the same, it cannot possibly be said that Appellants have had "a fair opportunity to react" to the Examiner's interpretation of the motivation requirement in view of KSR. See MPEP § 1207.03 (III) (Rev. 3, Aug.2005).

Moreover, the KSR Court did not reject the "teaching, suggestion, motivation" test completely, but rather stated that test captured a the "helpful insight" (Slip Opinion at 14), and helped to guard against the distortions caused by "hindsight bias" (Slip Opinion at 17). Appellants therefore submit that it was wrong for the Examiner to ignore the arguments in the Brief concerning motivation to combine.

More importantly, however, the KSR Decision does not absolve the Examiner from the requirement to make explicit findings that support an articulated rationale to combine known elements so as to meet the terms of the claim:

"Often, it will be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine if there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ***To facilitate review, this analysis should be made explicit.***" See *In re Kahn*, 441 F.3d, 977, 988 (CAFD, 2006). ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")." (KSR Slip Opinion at 14 emphasis added).

In fact, internal USPTO policy makes this an explicit requirement:

“Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary [for the examiner] to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed” (USPTO Memorandum dated May 3, 2007, “Supreme Court Decision in *KSR Int’l Co v. Teleflex, Inc.*”, copy attached.)

Notwithstanding the above, the KSR Decision has little bearing on the instant Appeal, for the reason that KSR addressed a situation in which all of the elements in each claim were known, whereas the current Appeal does not. This was acknowledged by the KSR Court itself, and echoed in the USPTO’s memo:

“Following these principles [concerning the combination of elements of prior art] may be more difficult in other cases than here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.” KSR, Slip Opinion at 13-14.

Thus, the KSR Court acknowledged that the situation it addressed was a situation where all elements of the claimed invention were known *per se*, and the question of obviousness thus devolved into one of whether it would be obvious to combine those known elements to yield the claimed invention. That situation is not present here, where as described above there are significant claimed features that are not present anywhere in the applied art.

Nonetheless, even in view of KSR, the Examiner's rationale for combining Sugiura and Cooper is deficient. In this regard, as discussed in the Appeal Brief and in detail above, Sugiura and Cooper fail to disclose or suggest the elements of Appellants’ claims. Still, even if the Examiner’s view of the references were to be accepted solely for

purpose of argument, the Examiner has still not provided a sufficient rationale to combine Sugiura and Cooper. In particular, the Examiner's Answer states:

"Sugiura teaches a method of print control allowing print message to be sent to a selected printer connected to the network (abstract). It is known in the print control art some printers may not support a print function requested by a user. Cooper addresses this problem in the print control field by providing support of the requested function if it is determined that the printer does not support the request function (col. 1, lines 50-64)." Examiner's Answer, page 28.

Like the Examiner's original rationale (Cooper would "increase the functionality" of Sugiura's system), the Examiner's new rationale simply proves too much.

The Examiner's rationale, when put in logical order, boils down to "Sugiura solves A. Cooper solves B. Even though Sugiura does not realize that it does not solve B, since Sugiura does not solve B, there is motivation to combine Sugiura and Cooper."

Under this rationale, every combination of references would be obvious, since (as here) the objective of one reference could simply be restated as missing from another reference. As seen by Appellants, KSR is not a license to simply restate the individual objective of one reference as the motivation to combine with another reference.

Moreover, Appellants' invention is not simply a choice from "a finite number of identified, predictable solutions". *KSR International Co. v. Teleflex Inc.*, slip op. at 17. In particular, there are almost limitless possible ways to provide functionality for legacy devices on a local network, and almost unlimited ways that responsibility for such functionality could be distributed across a computing device, a network client device, and a target network device. For example, functionality could be augmented at a target device by adding additional hardware directly to the target device, by downloading functionality

software from a server, by upgrading the software, by requesting and receiving at a client host device, and so on. Nevertheless, these myriad other potential solutions do not offer the advantages provided by Appellants' claimed invention.

Furthermore, the instant appeal falls far from the facts and intended purpose of KSR. In particular, in KSR and subsequent decisions, an obviousness determination was upheld when the references disclosed *different methods* of performing the *same function*. In contrast, in the present appeal, the references are directed to different functions.

Briefly, in KSR, the patented invention related to a sensor for controlling a car engine throttle attached to a mechanical pedal at a fixed pivot point. One prior patent disclosed a similar pedal without the sensor (Asano), and another that one could attach a sensor to a pedal's support structure (Smith). The prior art also disclosed attaching a sensor to the pedal's footpad (Rixon). See KSR, Slip op. at 3-5. Thus, the applied references in KSR focused not just on automobiles, and not just on throttle control of the engine of automobiles, but specifically on various ways to place a sensor on an automobile pedal.

This situation is echoed in a number of cases which have issued since KSR. In each case, the references to be combined were directed to different ways of performing the same function. See, e.g., *Ex Parte CAROLYN RAMSEY CATAN*, Appeal 2007-0820, slip op. at 17 ("the difference between the claimed subject matter and that of the prior art rests...in the very combination itself; that is, in the substitution of Harada's bioauthentication device for Nakano's manual authentication means."); *Ex Parte MARY SMITH*, Appeal 2007-1925, slip op. at 18 ("The substitution of the continuous, two-ply

seam of Dick for the folded seam of Wyant is thus no more than ‘the simply substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.’”); *Leapfrog Enterprises, Inc. v. Fisher-Price and Mattel, Inc.*, slip op. at 9 (Fed. Cir. May 9, 2007) (“[It would be] obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such an adaptation.”)

In contrast, the claimed subject matter is not a choice from a finite number of identified, predictable solutions to a problem, or an application of a known technique to a known system ready for improvement to yield predictable results, or a predictable variation of a known work that would have been promoted based upon design incentives. It can not possibly be said that bypassing network firewall security (Sugiura) and simulating print options such as N-up printing (Cooper) are different ways to perform the same function, or even similar functions. These functions are simply different. The Examiner’s rationale might be appropriate if Sugiura taught a different method for simulating print options instead of a method for bypassing network firewall security, or if Cooper taught a different way of bypassing network firewall security instead of a method for simulating print options. As it stands, however, Cooper and Sugiura are not directed to different ways of performing the same function, and instead are directed to different functions.

Moreover, Appellants submit that KSR was not intended to obliterate any differentiation between different fields of art, such that all that is needed is a recitation of a common term such as “printer”. Here, the Examiner’s vaguely asserted field of “print

control" would encompass any references tangentially related to printers, notwithstanding that one might be directed to bypassing network firewall security (Sugiura), while the other is directed to software simulations for print options (Cooper).

Thus, the Examiner's rationale simply restates the individual objective of one reference as the motivation to combine with another reference. Moreover, the instant appeal falls far from cases held to be obvious under KSR and subsequent decisions. Accordingly, even after KSR, the Examiner has not provided sufficient rationale to combine Sugiura and Cooper.

II. Independent Claim 33

- A. There is no *prima facie* case since important features of the claim are not found in the applied art.

Independent Claim 33 is directed to a rule-based method for mimicking a network device, and much like independent Claim 1, involves three participants: a computing device which performs the claimed method, a client network device, and a target network device. Rules are created in the computing device, and are used to make a determination if an incoming message requests a functionality that an application module in the computing device is configured to perform.

As asserted in Appellants' opening Brief, there are at least four features in Claim 33 that are not found in the applied art. In many cases, these features are somewhat similar to corresponding features not found in independent Claim 1, but in some cases

these features are somewhat more specific than their counterparts from Claim 1. For example, according to Claim 33, an incoming message is “addressed to an IP address” of a “designated one of the plurality of target network devices”, whereas in Claim 1 the incoming message was addressed “to a network address” of a “target network device residing on the local network”. Likewise, in Claim 33, the determination of whether the incoming message requests functionality that the application module is configured to perform is based at least in part on a rule, whereas Claim 1 is non-specific as to the method for such a determination.

The Examiner’s Answer does not address any of these features. Thus, in this Reply, Appellants will not make any further comments on them, other than to reassert and incorporate the arguments in their main Appeal Brief, to the effect that the Examiner has not made out a *prima facie* case of obviousness.

- B. There is no motivation to combine Sugiura and Cooper, or otherwise to modify the actual disclosures of these references to meet the language of the claims.

Initially, Appellants wish to point out that in view of KSR, this is also considered a new ground of rejection. Moreover, the Examiner has completely changed his rationale for combining Banginwar with Sugiura and Cooper. In the final rejection, the Examiner's rationale for adding Banginwar was that Banginwar "would increase the system alertness of Sugiura's and Cooper's systems by allowing new devices added to the system to be notify [sic, notified] to the user." However, the Examiner's Answer states that one

would be motivated to combine Banginwar "in order to allow a user to set control policies (rules) for determining how to process a print message in Sugiura's and Cooper's systems."

Nonetheless, as discussed in detail above, the proposed combination of Sugiura and Cooper is without proper legal basis. Therefore, Appellants submit that this further combination is deficient regardless of any further motivation to include Banginwar.

CONCLUSION

The Examiner's Answer variously substitutes its own broader language for Appellants' clear claim language, shifts its interpretation of the art when applying it to different elements of the same claim, interchanges language with different meanings, and states insufficient rationale for existing rejections. Accordingly, Appellants submit that the Examiner's Answer does not provide any reasoning to remedy the shortcomings of the final rejection, and the rejections should be reversed.

Appellants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

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